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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/447,284

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QINGHONG CAO

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EXAMINER

LY, NGHI H

ART UNIT

PAPER NUMBER

2686

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/27/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 15, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Jones et al (6,697,944).

Regarding claims 15 and 25, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public

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switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

Regarding claim 28, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing

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MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the remote bit stream music comprised in a MPEG format to the remote handset via an Internet (column 4, lines 27-33, see "transmission through Internet").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

4. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Rydbeck (WO 99143136).

Regarding claim 1, Borland teaches a cordless telephone (see Abstract), comprising: a remote handset (see fig. 2, handset 110), a base unit matched to the remote handset (see fig. 2, handset 120), and an MPEG audio player integrated within at least one of the remote handset and the base unit (see Abstract, "MP3", column 4,

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lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player, the switching being initiated upon activation of a button on the remote handset of the cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, Borland further teaches the MPEG audio player is integrated within the remote handset (see column 5, lines 24-28).

Regarding claims 4 and 5, Borland further teaches the MPEG audio player is an MP3 (see Abstract, "MP3", column 4, lines 7-21, "MP3").

Regarding claim 29, Borland further teaches a cordless telephone (see Abstract), comprising: means for playing pre-loaded MP3 music from a remote handset of a cordless telephone (see fig. 2, handset 110), means for connecting a base unit of the cordless telephone to a public switched telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7).

Borland does not specifically disclose switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone.

Rydbeck teaches switching a remote handset of the cordless telephone from performing as a telephony device to performing as an audio player, and switching being initiated upon activation of a button on the remote handset of said cordless telephone (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Borland in order to prevent telephone conversation from interfering with audio sounds.

5. Claims 14 and 24 are rejected under 35 U.S.C 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Jones et al (6,697,944) and further in view of Ng (US 6,430,530).

Regarding claims 14 and 24, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7), playing MP3 music from a remote handset of the cordless telephone (see column 5, lines 24-28), downloading digital bit stream music comprised in an MPEG format to the remote

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handset from a remote bit stream audio source (see Abstract, column 3, lines 2-5 and column 4, lines 2-7), the downloaded digital bit stream music comprised in an MPEG format is stored in memory in the remote handset (see column 4, lines 22-39, "storage in portable system").

Borland does not specifically disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source.

Jones teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source (see column 10, lines 9-14).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jones into the system of Borland in order to ensure proper protection and prevent unauthorized duplication thereof (see Jones, column 1, lines 8-14).

The combination of Borland and Jones does not specifically disclose an MPEG format is stored in memory.

Ng teaches an MPEG format is stored in memory (see column 1, line 62-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Ng into the system of Borland and Jones so that the user can decodes and plays the file (see Ng, column 1, line 62-65).

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6. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borland et al (US 6,556,965) in view of Tuoriniemi et al (US 5,978,689).

Regarding claims 9 and 19, Borland teaches a method of integrating an MPEG audio player in a cordless telephone (see Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG") comprising: playing of the pre-loaded MP3 music from the remote handset of a cordless telephone (see column 5, lines 24-28), connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see "PSTN" and column 4, lines 2-7) and playing of the pre-loaded MP3 (column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Regarding claims 10 and 20, Borland teaches the method of integrating an MPEG audio player in a cordless telephone according to claims 9 and 19 (see Abstract,

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"MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see column 3, line 65 to column 4, line 7, "MPEG").

Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Borland so that the user won't miss the telephone call while enjoy listening to music.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 have been considered but are moot in view of the new ground(s) of rejection.

On page 8 of applicant's remarks, applicant argues that Rydbeck fails to disclose a remote handset of a cordless telephone that can switch between performing as telephone device and performing as an MPEG audio player as recited in the claims.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986). In this case, Borland teaches a remote handset of a cordless telephone that can perform as an MPEG audio player (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3") (also see Borland, column 3, line 65 to column 4, line 7, "MPEG"), Rybeck teaches a remote handset that can switch between performing as telephone device and performing as an audio player (see Rybeck, page 7, lines 2-4) and the combination of Borland and Rybeck does indeed teach applicant's claimed invention.

In addition, both Borland's cordless telephone and Rybeck's wireless telephone are communication devices, and those skilled in the art would appreciate that the teaching of Rybeck can also be used in the Borland's cordless telephone without changing the scope and spirit of Rybeck's and/or Borland's inventions.

On page 11 of applicant's remarks, applicant argues that Borland fails to disclose an MPEG signal that stored in the memory and Ng fails to disclose a remote handset of a cordless telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Ng teaches an MPEG signal that stored in the memory, Borland teaches a remote handset of a cordless telephone and the combination of Borland and Ng does indeed teach applicant's claimed limitation. In addition applicant's attention is directed to the rejection of claims 14 and 24 above.

On page 11 of applicant's remarks, applicant further argues that Ng fails to teach the use of compressed music.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compressed music) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On pages 12 and 13 of applicant's remarks, applicant further argues that Tuoriniemi fails to teach playing MP3 music from the remote handset of a cordless telephone and muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Borland teaches playing MP3 music from the remote handset of a cordless telephone, Tuoriniemi teaches muting the playing of music when the remote handset is active in a current telephone, and the combination of Borland and Tuoriniemi does indeed teach applicant's claimed limitation. In addition applicant's attention is directed to the rejection of claims 9, 10, 19 and 20 above.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

NHL
07/21/05

Charles Appiah
CHARLES APPIAH
PRIMARY EXAMINER